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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,078	05/04/2001	J. Roger Kelley	046362.007001.0003	8140
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Robert C. Curfiss Jackson Walker L.L.P. Suite 2100 112 E. Pecan, San Antonio, TX 78205			WONG, LESLIE	
			ART UNIT	PAPER NUMBER
			2164	
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/849,078	KELLEY, J. ROGER
	<b>Examiner</b>	<b>Art Unit</b>
	Leslie Wong	2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 April 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 May 2001 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 April 2006 has been entered.

### ***Declaration under 37 CFR 1.131***

2. The Declaration of Prior Invention filed on 17 April 2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the effective date of the Singer et al. (US 20030115198 A1) reference.

The evidence submitted in the Declaration is insufficient to establish a "conception" and a "diligence" of the invention prior the effective date of the Singer reference.

In terms of conception, the Declaration shows only that the Applicant had an idea. However, the evidence fails to show adequate proof that the ordinary skill in the art could have reduced the idea in the form of the claims to practice. For example, Document I dated March 17 1998 to Document IV dated July 8 2000, show the draft Flow Chart, draft Business Plan, facsimile of Draft Document titled "ENDC PROCESS

FLOW OVERVIEW", and an internal newsletter before the effective date of the reference (September 1, 2000).

The elements recited in claim 1, "a. collecting external data externally generated from and unrelated to a specific facility but required for compliance requirements of a governmental compliance model; b. collecting internal data uniquely associated with said facility and internally generated from said facility; c. assimilating the external data and the internal data in a processor to determine compliance by the user; d. automatically generating a report based on the assimilation, which report is unique to the facility and contains the required governmental compliance information.", appear to be essential to the invention in the context of the claim is not mentioned anywhere in the Declaration.

Hence, no facts have been shown to evidence that Applicant had a "complete and operative invention" formed in the Applicant's mind.

Applicant does not meet the burden for satisfactory evidence of the fact of prior invention as set forth in MPEP 715.07. In particular, **the correspondence between elements of the claims and the evidence presented (i.e., draft Flow Chart) has not been addressed.**

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. *In re Tanczyn*, 347 F.2d 830,146 USPQ 298 (CCPA 1965). See MPEP § 715.02

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897); it was established that conception is

more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

Conception has been defined as “the complete performance of the mental part of the inventive act” and it is “the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice....” *Townsend v. Smith*, 36 F.2d 292, 295, 4 USPQ 269, 271 (CCPA 1930). Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without “exercise of the inventive faculty.” *Gunter v. Stream*, 573 F.2d 77, 197 USPQ 482 (CCPA 1978). See also *Coleman v. Dines*, 754 F.2d 353, 224 USPQ 857 (Fed. Cir. 1985) (It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.); *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F. 2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) (Conception is the “formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is thereafter to be applied in practice.”).

In terms of diligence, there are gaps between the documents included in the Declaration without explanation. For example, the **gap of five months** between Document I and Document II, the **gap of sixteen months** between Document II and Document III, the **gap of seven months** between Document III and Document IV, etc., **all without explanation**.

According to the law, merely stating that there were no weeks or months that the invention was not worked on is not enough, let alone there are so many gaps between the proof documents in the Declaration.

An applicant must account for **the entire period** during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter “was diligently reduced to practice” is not a showing but a mere pleading). **A 2-day period lacking activity has been held to be fatal.** In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (**Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice.** An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicant must be specific as to dates and facts.).

The significant elements of no independent claim are expressed or fairly suggested in the documents presented for evidence of conception. The showing of diligence is thus moot, as in determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. Ex parte Kantor, 177 USPQ 455 (Bd. App. 1958).

Based on the above, the evidence within the Declaration, from Document I to Document IV, is insufficient proof that Applicant had a conception of the invention prior the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application.

Therefore, the Declaration submitted by Applicant does not overcome the effective date of the Singer reference.

#### ***Examiner's Remarks***

3. Tables associated with the claims do not maintain the spatial relationships (e.g., columns and rows) of the table elements and preserve the information they convey after have been imaged from the PTO IFW imaging system. Appropriate correction is required.

#### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities: it appears that limitation "... from **and** unrelated to a specific facility" in claim 1a. should be "... from **an** unrelated ...". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by **Singer et al. ('Singer')** (US 20030115198 A1).

Regarding claim 1, **Singer** teaches a method for collecting, assimilating and utilizing data from a variety of sources for determining the regulatory requirements and for generating the related compliance reports for a specific facility in a given industry, the method comprising the steps of:

- a). collecting data externally generated from and unrelated to a specific facility but required for compliance requirements of a governmental compliance model (col. 3, lines 32-35);
- b). collecting data uniquely associated with said facility and internally generated from said facility (col. 9, lines 58-67);
- c). assimilating the external data and the internal data in a processor to determine compliance by the user (col. 5, lines 10-15; col. 6, lines 13-19; col. 9, lines 13-21);
- d). automatically generating a report based on the assimilation, which report is unique to the facility and contains the required governmental compliance information (col. 2 lines 19-21).

Regarding claim 2, **Singer** further teaches wherein the external data is collected via the Internet (col. 1, lines 59-61 and col. 2, lines 43-47).

Regarding claim 3, **Singer** further teaches wherein the compliance model is a government agency compliance requirement (col. 3, lines 32-35).

Regarding claim 4, **Singer** teaches the step of electronically submitting the generated report to a relevant agency (col. 10, lines 25-29).

Regarding claim 5, **Singer** further teaches wherein the collected public data is industry specific (col. 10, lines 49-52).

Regarding claim 6, **Singer** further teaches wherein the collected user data is facility specific (col. 5 lines 7-10).

Regarding claim 7, **Singer** further teaches wherein the collected user data is equipment specific (col. 5 lines 7-10).

Regarding claim 8, **Singer** further teaches wherein the collected user data is location specific (col. 5 lines 7-10).

Regarding claim 9, **Singer** further teaches including the step of creating a library of available data from the collected public data and non-confidential portions of the collected user data (col. 3, lines 24-35).

Regarding claim 10, **Singer** further teaches linking the public data to on-line databases and importing data from said databases into the collected public data (col. 6, lines 13-19).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Singer et al.** ('**Singer**') (US 20030115198 A1) as applied to claims 1-10 above and in view of **Dominguez et al.** (U.S. Patent 5,668,735).

Regarding claim 11, **Singer** teaches collected public data (col. 1, lines 59-61 and col. 2, lines 43-47).

**Dominguez**, however, teaches a mathematical database and collected user data and imported into the mathematical database for calculating compliance data in the generation of a report (col. 24, lines 41-65 and col. 23, lines 11-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Dominguez's** teaching would have allowed **Singer's** to provide a central repository of regulated information in order to facilitate accessing information and enhancing the process of preparing and submitting of compliance data to related agency.

9. Claims 12-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Singer et al. ('Singer')** (US 20030115198 A1) and **Dominguez et al.** (U.S. Patent 5,668,735) as applied to claim 11 above and in view of EPA Document AP-42 and standard engineering/industry calculations according to Applicant submission under 37 CFR 1.105.

Regarding claim 12, **Singer and Dominguez** do not explicitly teach wherein the mathematical database is an air module database for calculating hydrocarbon emissions from a crude oil storage tanks.

However, Applicant submission under 37 CFR 1.105 indicates that the emissions formula for hydrocarbon emissions from a crude oil storage tank can be found in Chapter 5 of the EPA Document AP-42.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to employ a mathematical database that contains the formulas for calculating hydrocarbon emissions from a crude oil storage tanks as doing so would

facilitate access and retrieval of formulas to calculate hydrocarbon emissions from a crude oil storage tanks and other emissions which required by the agency.

Regarding claim 13, **Singer and Dominguez** do not explicitly teach wherein the mathematical database includes the primary calculation formulas for calculating hydrocarbon emissions from storage tanks.

However, Applicant submission under 37 CFR 1.105 indicates that the emissions formula for hydrocarbon emissions from storage tanks can be found in Chapter 7, Section 7.1 of the EPA Document AP-42.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the provided EPA emissions formulas to calculate hydrocarbon emissions from storage tanks in order to submit the emissions report to the EPA in accordance with EPA requirements.

Regarding claims 14-15, **Singer and Dominguez** do not explicitly teach wherein the mathematical database includes the primary calculation formulas for calculating hydrocarbon emissions from internal combustion engines.

However, Applicant submission under 37 CFR 1.105 indicates that the emissions formula for hydrocarbon emissions from internal combustion can be found in Chapter 3 of the EPA Document AP-42.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the provided EPA emissions formulas to calculate

hydrocarbon emissions from internal combustion engines in order to submit the emissions report to the EPA in accordance with EPA requirements.

Regarding claims 16-17, **Singer and Dominguez** do not explicitly teach wherein the mathematical database includes the primary calculation formulas for calculating hydrocarbon emissions from external combustion units.

However, Applicant submission under 37 CFR 1.105 indicates that the emissions formula for hydrocarbon emissions from external combustion units can be found in Chapter 1 of the EPA Document AP-42.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the provided EPA emissions formulas to calculate hydrocarbon emissions from external combustion units in order to submit the emissions report to the EPA in accordance with EPA requirements.

Regarding claims 18 and 19, **Singer and Dominguez** do not explicitly teaches the mathematical database includes the following primary calculation formulas for calculating emissions for *valves, flanges piping, and compressor seals*;

However, Applicant submission under 37 CFR 1.105 indicates that the emissions formula for emissions from emissions for *valves, flanges piping, and compressor seals* can be found in Chapter 7, Section 7.1 of the EPA Document AP-42.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the provided EPA emissions formulas to calculate

emissions from emissions for *valves, flanges piping, and compressor seals* in order to submit the emissions report to the EPA in accordance with EPA requirements.

Regarding claim 20, **Singer and Dominguez** do not explicitly teach the mathematical database includes the following primary calculation formulas for calculating emissions for glycol dehydration units.

However, Applicant submission under 37 CFR 1.105 indicates that the emissions formula for glycol dehydration units can be found in Attachment No. 5.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the provided EPA emissions formulas to calculate emissions for glycol dehydration units in order to submit the emissions report to the EPA in accordance with EPA requirements.

Regarding claim 21, **Singer and Dominguez** do not explicitly teach calculating flash emissions caused by the transfer of higher pressure liquids from a process vessel to a storage tank of less pressure.

However, Applicant submission under 37 CFR 1.105 indicates that the calculation of flash emissions caused by the transfer of higher pressure liquids from a process vessel to a storage tank of less pressure by utilizing one of the following:

- 1). standard petroleum engineering calculation (i.e., Vaquez-Beggs Gas Oil Ratio and Black Oil GOR 2);

- 2). Standard testing of samples and gas oil ratio calculation from gas evolved during this test; or
- 3). API-E&P Calculation routine using industry stand software.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the above standard emissions formulas to calculate flash emissions caused by the transfer of higher pressure liquids from a process vessel to a storage tank of less pressure in order to submit the emissions report to the EPA in accordance with EPA requirements.

Regarding claim 22, **Singer and Dominguez** do not explicitly teach calculation of loading loss emission.

However, Applicant submission under 37 CFR 1.105 indicates that the emissions formula for loading loss emissions can be found in Chapter 5, Section 5.2 of the EPA Document AP-42.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the provided EPA emissions formulas to calculate hydrocarbon emissions from storage tanks in order to submit the emissions report to the EPA in accordance with EPA requirements.

Regarding claim 23, **Singer et al.** further teaches wherein the mathematical database includes the primary calculation formulas for calculating emissions fees (col. 8, lines 22-30).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (571) 272-4120. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES RONES can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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